

**REMARKS**

**ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116**

Applicant requests entry of this Rule 116 Response and Request for Reconsideration because:

- (a) it is believed that new claims 7 and 8 put this application into condition for allowance; and/or
- (b) the amendments were not earlier presented because the Applicant believed in good faith that the cited prior art did not disclose the present invention as previously claimed.

The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered." ( Underlining added for emphasis) Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

**NEW CLAIMS**

New claim 7 recites that the features of the present invention include a transmission system for transmitting digital signals between a TDM network connected via an exchange termination and TDM-based terminal equipment connected via a line termination, comprising: an ATM network having user interfaces; connection units, provided respectively at the exchange termination and the line termination to respectively connect each of the exchange termination and the line termination to one of the user interfaces of the ATM network; conversion units provided respectively at the exchange termination and the line termination, to convert time-division multiplex data into ATM cells, or ATM cells into time-division multiplex data, the conversion units serving the function of a V<sub>1</sub> reference point; and an allocation unit to allocate a virtual ATM channel to each time-division multiplex channel.

Independent claim 7 therefore clearly refers to a V<sub>1</sub> reference point. V<sub>1</sub> reference points are defined in ITU-T Recommendation Q.512, a copy of which is enclosed. As can be seen, the functions of the V<sub>1</sub> reference point may include (2B+D) channels, bit timing, frame timing, activation, deactivation, operation and maintenance and power feed.

Nothing in the prior art teaches or suggests such a transmission system. It is submitted

that new claim 7 distinguishes over the prior art.

New claim 8 recites that the features of the present invention include an ISDN subscriber terminal, comprising: a receiver to receive digital time division multiplexed signals; a transmitter to transmit digital time division multiplexed signals; a conversion unit to convert time-division multiplexed data into ATM cells and convert ATM cells into time-division multiplexed data, the conversion unit having a TDM side connected to the receiver and transmitter and having an ATM side, the conversion unit serving the functions of a V1 reference point; and a connection unit to connect the subscriber terminal to a broadband, packet oriented ATM network, and allow the subscriber terminal to be moved from one location to another, the connection unit communicating data between the conversion unit and the ATM network.

Independent claim 8 describes one of the main features of the invention, enabling ISDN user equipment to be moved without reconfiguring connection lines. See the paragraph bridging pages 2 and 3 of the application and the paragraph bridging pages 3 and 4 of the application, for example.

Nothing in the prior art teaches or suggests such an ISDN subscriber terminal. It is submitted that new claim 8 distinguishes over the prior art.

### **REJECTION UNDER 35 U.S.C. §103**

In the Office Action, at pages 2-4, numbered paragraph 2, the Examiner repeats his rejections of claims 1-4 and 6 under 35 USC § 103 as being unpatentable over Duault et al. (U.S. Patent No. 5,638,365) in view of Norizuki et al. (U.S. Patent No. 5,675,574) and Yamada et al. (U.S. Patent No. 5,412,655). Claim 5 is separately rejected on page 4 of the Office Action. The rejection of claim 5 relies upon a fourth reference, U.S. Patent No. 5,673,258 to Helbig et al.

The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

It is respectfully submitted that since none of the Duault et al., Norizuki et al. and Yamada et al. teach or suggest the transmission system and the ISDN subscriber terminal of the present invention, the combination of Duault et al., Norizuki et al. and Yamada et al. also does not teach or suggest the transmission system and ISDN subscriber terminal of the present invention.

It is respectfully submitted that, in *In re Dembiczak*, the court noted that:

Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field.

*In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). One "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988).

The case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." *Id.* "When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) (citing *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)). "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Although the suggestion to combine references may flow from the nature of the problem, see *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), "[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness," *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998). Therefore, "[w]hen determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" *In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting *Lindemann*, 730 F.2d at 1462, 221 USPQ at 488).

The Examiner does not discuss any specific evidence of motivation to combine, but only makes conclusory statements.

"Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. The Examiner provides no support for his broad conclusory statement: "It would have been obvious to one [of]

ordinary skill in the art at the time invention was made to substitute [a] line termination, such as that suggested by Norizuki, to the DTE of Duault in order to provide a connection between [an] ATM network and a TDM network and to enable a narrow-band communication between subscriber terminals."

The Examiner appears to make implicit findings, but can point to nothing that suggests the combination of the Duault et al., Norizuki et al. and Yamada et al. to then suggest the present invention. However, while these references teach a low line current harmonic power supply, adapted to receive power from an AC line, the power supply including: a rectifier responsive to the AC line voltage; a capacitor disposed in parallel across the output of the power supply; an energy transformation circuit interposed between the rectifier and the capacitor; a power switch, responsive to a control signal applied thereto, for selectively energizing the energy transformation circuit; a control circuit, for generating the control signal to the power switch, the control circuit including: a pulse width modulator, responsive to a modulation control signal applied thereto for generating the control signal to the power switch; a first error signal generator for generating an output voltage error signal indicative of the deviation of the output voltage of the power supply from a predetermined reference voltage; a second error signal generator for generating an RMS error signal indicative of the deviation of RMS voltage of the AC line from a predetermined reference value; synthesizing mean, phase-locked to the voltage waveform of the AC line, for synthesizing indicia of a desired input current waveform reference; a multiplier, responsive to the indicia of the desired waveform, the output voltage error signal, and the RMS error signal; a current sensor for generating a signal indicative of the current from the rectifier; and a differencing amplifier, receptive of the outputs of the current sensor and the multiplier, for generating the modulation control signal (See claim 1 of Duault et al.), a congestion control system for controlling congestion in an interface between a PBX (Private Branch Exchange) and an ATM (Asynchronous Transfer Mode) multiplexing transmission unit which is connected to an ATM network via an ATM transmission line, said congestion control system comprising: congestion detecting means positioned in said ATM multiplexing transmission unit, for detecting a congested state in which the ATM transmission line is congested with traffic; and control means, coupled to said congestion detecting means, for congestion control operation such that when the congested state is detected by the congestion detecting means said control means produces a pseudo busy state which is detected at said PBX and inhibits a call from the PBX from being sent to the ATM transmission line via the ATM multiplexing transmission unit in response to said pseudo busy state (see Norizuki et al. claim 1), and a multiprocessing system for disassembling asynchronous transfer mode (ATM) cells into multiplex data on a multiplex

transmission line having a plurality of channels, comprising: a buffer memory logically divided into a plurality of data banks, each bank being capable of storing the payload data of an ATM cell; accumulation control means for specifying one unused bank of said buffer memory to store the payload data of a received ATM cell; storage means for storing a collection of addresses of the banks, each storing the payload data of the received ATM cell, said collection being formed for each virtual channel of received ATM cells; and disassembly control means for reading out data as the multiplex data from said buffer memory according to a bank address read out from said collection for the virtual channel corresponding to each channel of the multiplex transmission line (see Yamada et al. claim 1), neither reference suggests combining, nor provides any motivation to so combine, the elements to achieve applicants' invention, A transmission system for transmitting digital signals between a TDM network connected via an exchange termination and TDM-based terminal equipment connected via a line termination, comprising: an ATM network having user interfaces; connection units, provided respectively at the exchange termination and the line termination to respectively connect each of the exchange termination and the line termination to one of the user interfaces of the ATM network; conversion units provided respectively at the exchange termination and the line termination, to convert time-division multiplex data into ATM cells, or ATM cells into time-division multiplex data; and an allocation unit to allocate a virtual ATM channel to each time-division multiplex channel (see Applicants' claim 1).

It is respectfully submitted that Dault et al. actually teaches away from combining the Norizuki et al and Yamada et al. inventions with the Dault et al. method to achieve the present invention.

The combination of the teachings disclosed in the cited references (Duault et al., Norizuki et al. and Yamada et al.) was only theoretically feasible having already in mind the claimed invention. However, no reference motivates - either isolated or in combination with the other references - one skilled in the art to substitute a V reference point and a narrow band TDM communication system with an ATM network that is rather used for broadband communications. Independent claims 7 and 8 in particular recite the V<sub>1</sub> reference point features.

It is respectfully submitted that the absence of a convincing discussion of the specific sources of the motivation to combine the prior art references, particularly in light of the strength of prior art teaching away from the use of the devices of Norizuki et al. and Yamada et al. in the Dault et al. device, is a critical omission in the Examiner's obviousness analysis, which mainly begs the question with respect to motivation for combining prior art references to read on the

claimed invention. This citation of the three references and submission that it would have been obvious to combine same wholly fails to demonstrate how the prior art teaches or suggests the combination claimed in the present invention.

Because Applicant does not discern any suggestion, teaching, or motivation to combine the prior art references cited against the claimed invention, and even if combined, the cited references fail to teach or suggest the present invention, it is respectfully submitted to that the combination is insufficient to suggest that the present invention is obvious. The implicit generalized finding by the Examiner that, when one of ordinary skill in the art was faced with the problem of obtaining a high definition display and the '128 patent, the combination claimed by the present invention would have been obvious is submitted to be insufficient. The court has previously held that "[t]he suggestion to combine may be found in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved." WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). However, there still must be evidence that "a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." In re Rouffet, 149 F.3d at 1357, 47 USPQ2d at 1456; see also In re Werner Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("[A] rejection cannot be predicated on the mere identification . . . of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed."). Here, there was no such evidence presented. The only evidence on this issue presumes the very problem at hand-- that if someone of ordinary skill in the art had been given the Dault et al. reference on February 6, 1996 (the date of the priority application for the present invention) and [if] they were asked to provide something that would enable a subscriber terminal to be moved from a location inside the communication apparatus to another location, without reconfiguring metallic connection lines, they would have come up with the present invention. The evidence available, however, indicates that if one of ordinary skill in the art had been given the Dault et al. reference they would not have been inclined to use the Norizuki et al. and Yamada et al. because no reference discusses the concepts the present invention, i.e., building of narrow band communications networks in a cost effective way offering the feature of easy to move subscriber terminal. Discussing that objective would be a prerequisite for conveying incentives of one of skilled in the art in order to arrive at the claimed invention. Hence, the Applicant respectfully submits that the

Examiner's contention that a skilled artisan would combine these references is clearly erroneous.

### **CONCLUSION**

In accordance with the foregoing, new claims 7 and 8 have been added. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-8 are pending and under consideration. Reconsideration is respectfully requested.

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

Serial No. «Serial\_No»

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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